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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,315	05/16/2005	Zhicheng Shen	60163USPCT	2385

22847 7590 08/07/2007
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EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
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1638

MAIL DATE	DELIVERY MODE
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08/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Interview Summary	Application No.	Applicant(s)	
	10/505,315	SHEN ET AL.	
	Examiner	Art Unit	
	Anne R. Kubelik	1638	

All participants (applicant, applicant's representative, PTO personnel):

(1) Anne R. Kubelik. (3) _____.

(2) Greg Warren. (4) _____.

Date of Interview: 03 August 2007.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.
If Yes, brief description: _____.

Claim(s) discussed: all.

Identification of prior art discussed: _____.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: New matter rejection was discussed. Applicant urges that support is found in Vip3Ca and Vip3Cb, which differ at amino acid 738 (Error in Office action); SEQ ID NO:2 has X at that position. Both homologs have ECB activity; C-terminus is responsible for that activity; also isolated third Vip3C isolate with that terminus. Examiner said there is no support for any toxin with 97% sequence identity to SEQ ID NO:2 and with a C-terminus comprising amino acids 661-788 of SEQ ID NO:2. Applicant urges that original claims claims 54 and 57 provide support; Examiner will check after Applicant submits response. Document sent by Applicant summarizing their position attached to Summary. .

60163 Support for argument that amendment did not add new matter.

Specification

Example 3 (page 47) describes isolating two (2) Vip3C homologs, Vip3C(a) and Vip3C(b) from two (2) different Bt strains (C536 and C1674). The two homologs differ only at position 738, wherein Vip3C(a) has Glu (E) and Vip3C(b) has Gly (G). The sequence of both homologs is shown as SEQ ID NO: 2 in the sequence listing.

Example 6 (page 50) shows that both Vip3C(a) and Vip3C(b) are active against ECB.

Example 9 (pages 53 & 54) describe a Vip3 toxin that is made by taking the C-terminus of Vip3C(b) (amino acids 661-788 of SEQ ID NO: 2) and fusing that C-terminus to a Vip3A N-terminal sequence. This toxin is shown to now have activity against ECB indicating that the C-terminal amino acids of SEQ ID NO: 2 are sufficient to confer ECB activity. The sequence of this toxin is disclosed as SEQ ID NO: 11 and has 97% identity to SEQ ID NO: 2.

Example 12 (pages 57 & 58) describe the isolation of another Vip3C homolog, Vip3C-12168, using a cosmid library approach. The sequence of this toxin is disclosed as SEQ ID NO: 32 and has 99% identity to SEQ ID NO: 2.

Example 13 (page 58) shows that Vip3C-12168 is active against ECB.

Sequence Listing (page 3)

SEQ ID NO: 2 Vip3C toxin shows that the amino acid at position 738 is either Glutamine (Glu; E) or Glycine (Gly; G).

SEQ ID NO: 11 Hybrid Vip3A:Vip3C is 97% identical to SEQ ID NO: 2 and has amino acids 661-788 of SEQ ID NO: 2. SEQ ID NO: 11 has a "G" at position 738 because it was constructed using Vip3C(b).

SEQ ID NO: 32 is the Vip3C-12168 toxin is 99% identical to SEQ ID NO: 2. Vip3C-12168 has a Glu (E) at position 738 just like Vip3C(a).

Original Claims

Claim 54 depends from claim 49 and adds the limitation that the isolated toxin comprises amino acids 661-788 of SEQ ID NO: 2.

Claim 57 depends from claim 49 and adds the limitation that the isolated toxin comprises an amino acid sequence that has at least 97% identity to SEQ ID NO: 2.

Claim 80 depends from claim 49 and adds the limitation that the isolated toxin is active against ECB.

Therefore, these three limitations were added to the original claim 49 to arrive at the amended claim 49 at issue in the Final Office Action.

Case Law

Schering v. Amgen 222 F.3d 1347, 55, USPQ2d 1650 (Fed. Cir. 2000) stated that the fundamental inquiry is whether the material added by amendment was inherently contained in the original application (cited Litton v. Whirlpool, F.2d 1423, 1438 (Fed. Cir. 1984)). To make this judgment, this court has explained that the new matter prohibition is closely related to the adequate disclosure requirements of 35 USC §112.

In re Smythe, 480 F.2d 1376, 178 (CCPA 1973) held that in order to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter (here 97% identity and comprising 661-788 of SEQ ID NO: 2) is necessarily present in the thing described..., and that it would be so recognized by persons of ordinary skill.

Koito v. Turn-Key-Tech, 381 F.3d 1142 (Fed. Cir. 2004) held that because...amended material is inherently contained in the original application, it cannot constitute new matter.

MPEP

2163.07(a) [page 2100-185] By disclosing in a patent application a device [a composition; e.g. a protein] that inherently performs a function or has a property..., a patent application necessarily discloses that function...or [property], even though it says nothing explicit concerning it. The application may later be amended to recite the function or [property] without introducing prohibited new matter.